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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : PATENT  
:   
: Jan TUMA :   
:   
Serial No.: 10/577,233 : Art Unit: 1774  
:   
Filed: April 26, 2006 : Examiner:  
:   
For: **PROCESS FOR CREATING** :   
: **ADHESION ELEMENTS ON A** :   
: **SUBSTRATE MATERIAL** :

**SUBMISSION OF ENGLISH LANGUAGE  
PRELIMINARY EXAMINATION REPORT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Submitted herewith is an English language Preliminary Examination Report for the above-identified application.

Respectfully submitted,

Mark S. Bicks  
Reg. No. 28,770

Roylance, Abrams, Berdo & Goodman, LLP  
1300 19th Street, NW, Suite 600  
Washington, DC 20036  
(202)659-9076

Dated: December 19, 2006

**PCT**

NOTIFICATION OF TRANSMITTAL  
OF COPIES OF TRANSLATION  
OF THE INTERNATIONAL PRELIMINARY REPORT  
ON PATENTABILITY  
(CHAPTER I OR CHAPTER II  
OF THE PATENT COOPERATION TREATY)  
(PCT Rules 44bis.3(c) and 72.2)

From the INTERNATIONAL BUREAU

To:

**BARTELS UND PARTNER**  
**PATENTANWÄLTE**

Eingegangen:

29. NOV. 2006

**BARTELS UND PARTNER**  
 Lange Strasse 5  
 70174 Stuttgart  
 ALLEMAGNE

TERMIN .....

Date of mailing (day/month/year) 23 November 2006 (23.11.2006)	<b>IMPORTANT NOTIFICATION</b>
Applicant's or agent's file reference 40rdb/129370	
International application No. PCT/EP2004/002963	International filing date (day/month/year) 20 March 2004 (20.03.2004)
Applicant <b>GOTTLIEB BINDER GMBH &amp; CO. KG et al</b>	

**1. Transmittal of the translation to the applicant.**

The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter I).



The International Bureau transmits herewith a copy of the English translation of the international preliminary report on patentability (Chapter II).

**2. Transmittal of the copy of the translation to the designated or elected Offices.**

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following designated or elected Offices requiring such translation:

None

The following designated or elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

AE, AG, AL, AM, AP, AT, AU, AZ, BA, BB, BG, BR, BW, BY, BZ, CA, CH, CN, CO, CR, CU, CZ, DE, DK, DM, DZ, EA, EC, EE, EG, EP, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MA, MD, MG, MK, MN, MW, MX, MZ, NA, NI, NO, NZ, OA, OM, PG, PH, PL, PT, RO, RU, SC, SD, SE, SG, SK, SL, SY, TJ, TM, TN, TR, TT, TZ, UA, UG, US, UZ, VC, VN, YU, ZA, ZM, ZW

**3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).**

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary report on patentability (Chapter II).

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned within the applicable time limit (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Authorized officer

**Agnes Wittmann-Regis**

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# PATENT COOPERATION TREATY

# PCT

## INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

Applicant's or agent's file reference 40rdb/129370	<b>FOR FURTHER ACTION</b>		See item 4 below
International application No. PCT/EP2004/002963	International filing date ( <i>day/month/year</i> ) 20 March 2004 (20.03.2004)	Priority date ( <i>day/month/year</i> ) 12 March 2004 (12.03.2004)	
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237			
Applicant GOTTLIEB BINDER GMBH & CO. KG			

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).

2. This REPORT consists of a total of 6 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- |  |   |
|--|---|
| <input checked="" type="checkbox"/> Box No. I  | Basis of the report   |
| <input checked="" type="checkbox"/> Box No. II | Priority  |
| <input type="checkbox"/> Box No. III           | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input type="checkbox"/> Box No. IV            | Lack of unity of invention  |
| <input checked="" type="checkbox"/> Box No. V  | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> Box No. VI            | Certain documents cited   |
| <input type="checkbox"/> Box No. VII           | Certain defects in the international application  |
| <input type="checkbox"/> Box No. VIII          | Certain observations on the international application   |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland  Facsimile No. +41 22 338 82 70	Date of issuance of this report 14 November 2006 (14.11.2006)
	Authorized officer  <b>Agnes Wittmann-Regis</b>  e-mail: pt06@wipo.int

# PATENT COOPERATION TREATY

TRANSLATION

PCT

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

From the  
INTERNATIONAL SEARCHING AUTHORITY

To:

Date of mailing  
(day/month/year)

**See form PCT/ISA/210**

Applicant's or agent's file reference

**40rdb/129370**

**FOR FURTHER ACTION**

See paragraph 2 below

International application No.

**PCT/EP2004/002963**

International filing date (day/month/year)

**20.03.2004**

Priority date (day/month/year)

**12.03.2004**

International Patent Classification (IPC) or both national classification and IPC

**A44B18/00**

Applicant

**GOTTLIEB BINDER GMBH & CO. KG**

1. This opinion contains indications relating to the following items:

- |                                     |              |  |
|-------------------------------------|--------------|--|
| <input checked="" type="checkbox"/> | Box No. I    | Basis of the opinion   |
| <input checked="" type="checkbox"/> | Box No. II   | Priority   |
| <input type="checkbox"/>            | Box No. III  | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability   |
| <input type="checkbox"/>            | Box No. IV   | Lack of unity of invention   |
| <input checked="" type="checkbox"/> | Box No. V    | Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/>            | Box No. VI   | Certain documents cited  |
| <input type="checkbox"/>            | Box No. VII  | Certain defects in the international application   |
| <input type="checkbox"/>            | Box No. VIII | Certain observations on the international application  |

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/EP

Authorized officer

Facsimile No.

Telephone No.

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/002963

Box No. I

Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.  
☐ This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rule 12.3 and 23.1(b)).
2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
  - a. type of material  
☐ a sequence listing  
☐ table(s) related to the sequence listing
  - b. format of material  
☐ in written format  
☐ in computer readable form
  - c. time of filing/furnishing  
☐ contained in the international application as filed.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table(s) relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/002963

Box No. II

Priority

1. ☒ The following document has not yet been furnished:

☒ copy of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(a)).

☐ translation of the earlier application whose priority has been claimed (Rule 43bis.1 and 66.7(b)).

Consequently it has not been possible to consider the validity of the priority claim. This opinion has nevertheless been established on the assumption that the relevant date in the claimed priority date.

2. ☐ This opinion has been established as if no priority had been claimed due to the fact that the priority claim has been found invalid (Rules 43bis.1 and 64.1). Thus for the purposes of this opinion, the international filing date indicated above is considered to be the relevant date.

3. Additional observations, if necessary:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/EP2004/002963

Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

**1. Statement**

Novelty (N)

Claims 3-6, 8, 9

YES

Claims 1, 2, 7

NO

Inventive step (IS)

Claims 4-6, 8, 9

YES

Claims 1-3, 7

NO

Industrial applicability (IA)

Claims 1-9

YES

Claims \_\_\_\_\_

NO

**2. Citations and explanations:**

- 1 The present report makes reference to the following document:

D1: WO 01/49776 A (THE REGENTS OF THE UNIVERSITY OF CALIFORNIA ET AL) 12 July 2001 (2001-07-12)

- 2 INDEPENDENT CLAIM 1

- 2.1 The present application fails to meet the requirements of PCT Article 33(1) because the subject matter of claim 1 is not novel (PCT Article 33(2)).

Document D1 discloses (see e.g. figures 1e and 8, the references in parentheses are to D1):

A method for producing adhesion elements (29, 30) on a substrate using at least one synthetic material (152) that is placed in at least one molding element (150), thus shaping adhesion elements with widened ends (154) in such a manner that they adhere primarily as a result of van der Waals forces.

WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/EP2004/002963

Box No. V

Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement

- 3 The feature combination of claim 4 appears to meet the  
PCT requirements for novelty and inventive step.